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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VIDOVICH, GREGORY M

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,594

Applicant(s)

WILLIAMS ET AL.

Examiner

Gregory M. Vidovich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 April 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

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Detailed Action

Applicant's Response

1. In response to the Office action mailed 15 January 2002, applicant provides amendments to the specification, drawings, cancels claims 1-20, and adds new claims 24-34.

Regarding applicant's amendments to the specification, applicant provides incorrect instructions as to the application of the amendments. The amendment to "paragraph 16, page 4" should be --paragraph 14, page 3--, the amendment to "paragraph 19, page 5" should be --paragraph 18, page 5--, and the amendment to "paragraph 20, page 5" should be --paragraph 19, page 5--. These corrections have been made and applicant is hereinafter notified.

Applicant's election with traverse of in Paper No. 2 is acknowledged. Applicant, however, provides no arguments in the response.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. The proposed drawing correction filed on 23 April 2002 has been disapproved because it is not in the form of a pen-and-ink sketch showing changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v). Accordingly, the drawings as filed remain subject to examination.

3. The drawings are objected to because:

a) it is unclear as to how track elements 36 travel along guide elements 38; applicant provides no structure in the written description or drawings as to how this is remotely performed;

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b) it is unclear as to how rails 26 are collapsible in light of applicant providing no structure in the written description or drawings as to how this is performed; and

c) it is unclear as to the operation of the latching structure 54 in light of the extremely vague details and description provided by applicant. Correction is required.

4. The drawings as originally filed are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "56" and "58" found in amended paragraph 18 and "60" found in amended paragraph 19 are not found in the drawings as originally filed. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The amendment filed 23 April 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

in the amendment to paragraph 14, the insertion of the subject matter pertaining to the movement of the storage surface and the mounting structures expands applicant's disclosure beyond that as originally filed which provided extremely vague details as to how this is accomplished;

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in the amendment to paragraph 18, the insertion of the subject matter regarding a means for collapsing the rails expands applicant's disclosure beyond that as originally filed which provided extremely vague details as to how this is accomplished;

in the amendment to paragraph 19, indication of a "flush position" lacks support in the disclosure as originally filed which provided extremely vague details as to how this is accomplished.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. The disclosure is objected to because of the following informalities:

- a) it is unclear as to how rails 26 are collapsible;
- b) in figure 2, absent a guide element associated with the left side of the surface or the track element indicated as lead line 36 in figure 2, it is unclear as to how the surface may properly move between the respective positions as disclosed;
- c) it is unclear as to how track elements 36 travel along guide elements 38; applicant provides no structure in the written description or drawings as to how this is remotely performed;
- d) in paragraph 19 at line 3, only two mounting elements are illustrated; and
- e) it is unclear as to the operation of the latch 54 and as to how it remains flush and cooperates with the rack/surface.

Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 24-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 24, as discussed above, applicant provides extremely vague details as to the operation of the locking mechanism which is “movable to a position flush with the side of the vehicle.” One having ordinary skill in the art would not be enabled to make and use the invention based upon applicant’s written description which does not disclose how this is reasonably accomplished. Furthermore, the interaction between the storage surface and the mounting elements as discussed above is extremely vague. One having ordinary skill in the art would not be able to make and use the invention based upon applicant’s written description.

Regarding claim 26, applicant provides extremely vague details as to the operation of the end rail element which is “movable” as claimed.” One having ordinary skill in the art would not be enabled to make and use the invention based upon applicant’s written description which does not disclose how this is reasonably accomplished. See also claims 29, 30, and 34.

Applicant’s extremely vague written description does not render the ordinary artisan to make and use the subject matter in the invention set forth in the claims. Applicant’s attempts to satisfy the written requirement via the amendments to the disclosure clearly raise new matter and provide no

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merit as to the proper description, operation, and use of the invention within the level of skill of the ordinary artisan.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 24-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As set forth above, each of the claims include subject matter which is unclear based upon applicant's written description and renders the ordinary skilled artisan to clearly speculate as to what applicant considers as to the invention. For example, in claim 24, it is unclear as to the interaction of the mounting elements and the storage surface as well as to what is intended as the locking mechanism "movable to a position flush" with the side of the vehicle and as to how this locking mechanism interacts with the storage surface. Claim 25, it is unclear as to what is intended as the guide element and track element based upon applicant's vague written disclosure. Claim 26, it is unclear as to the movement and operation of the collapsible rail(s) in light of applicant's extremely vague written description. Applicant's attempts to bring in prior art teachings to provide support for applicant's vaguely disclosed invention clearly introduces new matter and provide no merit as to the proper description, operation, and use of the invention within the level of skill of the ordinary artisan.

11. If applicant continues to prosecute the application, revision of the drawings, specification, and claims to present the application in proper form is required. While an application can be

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amended to make it clearly understandable, **applicant is again reminded that no subject matter can be added that was not disclosed in the application as originally filed.**

Claim Rejections - 35 U.S.C. § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

13. Claims 24, 25, 27, and 28 are rejected under 35 U.S.C. 102(e)(2) as being anticipated by

Aftanas et al.

Regarding claim 24, the Aftanas reference discloses a roof rack comprising mounting elements (see proximate lead lines 14), a storage surface (see proximate lead lines 20, 22, 22), first and second transport positions (see figures 1-3) as claimed, and a locking mechanism (see figures 4, 5, 6, 6a, with emphasis on element 40) which is movable to a “flush” position as claimed (see figure 4).

Regarding claim 25, see proximate lead lines 18.

Regarding claim 27, see proximate lead lines 122 and 124 which define “at least one securing slot” in the track element.

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Regarding claim 28, see lead lines 25.

Claim Rejections - 35 U.S.C. § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 26 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aftanas et al. in view of Parkins.

Regarding claim 26, although the support surface does not include an end rail rotatable as claimed, attention is directed to the Parkins reference which discloses another storage surface (see proximate lead line 2) having end rail elements (24, 24) rotatably mounted thereto to increase the storage capacity of the surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide movable rails on the surface of the Aftanas reference as, for example, illustrated in Parkins in order to increase the storage capabilities of the storage surface in Aftanas.

Regarding claim 29, the Aftanas device as modified above includes a plurality of rails as claimed.

Response to Arguments

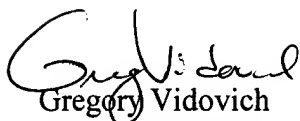
16. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection necessitated by applicant's amendments.

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17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Vidovich whose telephone number is (703) 308-1513.


Gregory Vidovich
Primary Examiner
Art Unit 3727
May 29, 2002